Application No. 09/391,462

Remarks

Applicants thank the Examiner for his careful consideration of the application.

Double Patenting Rejection

Claim 9 was rejected under the judicially created doctrine of obviousness-type double patenting of claim 1 of U.S. Patent No. 6,340,931 (the '931 patent). This rejection is respectfully traversed.

Claim 9 recites a method for N-space navigation of digital data sets, the method including first reading a first electronic tag having a digitally readable identifier with an electronic tag reader, with the digitally readable identifier triggering a first default navigational action, and second reading within a determined duration of the first reading step a second electronic tag having a digitally readable identifier with an electronic tag reader, with the digitally readable identifier triggering a second default navigational action.

Claim 1 of the '931 patent recites a printing control method using multiple electronic tags presented to an electronic tag reader connected to a network printer, the method comprising the steps of providing a first input from a first electronic tag, the first electronic tag having a first identification number that is associated with a network accessible document, and providing a second input from a second electronic tag after provision of the first input, the second electronic tag having a second identification number that invokes printing of the network accessible document associated with the first identification number.

Claim 1 of the '931 patent and Applicant's claim 9 recite different limitations. The first tag's identification number of claim 1 of the '931 patent is associated with a network accessible document. The second tag's identification number is associated with printing the document linked to the first tag's identification number. Applicant's claim 9 recites a first

electronic tag having a digitally readable identifier that triggers a first default navigational action, and a second electronic tag having a digitally readable identifier that triggers a second default navigational action. In Applicant's claim 9, both tags have identifiers that trigger actions. Apparently, the '931 patent discloses one identifier associated with an object and another associated with an action (printing). Withdrawal of the rejection is respectfully requested.

Claim Rejections 35 U.S.C. §103

Claims 1, 2, and 4-9 were rejected under 35 U.S.C. 103(a) as being unpatentable over Want et al, U.S. Patent No. 6,342,830 (the '830 patent) in view of Pulley et al., U.S. Patent No. 6,222,557 (the '557 patent). These rejections are respectfully traversed.

Claim 1 recites a system for N-space navigation of digital data sets, which includes an electronic tag having a digitally readable identifier, an electronic tag reader configured to read the identifier of the electronic tag, a computing system connected to the electronic tag reader to provide digital navigation services of N-space data sets in response to reading the identifier of the electronic tag, with the computing system generating at least one transitional data point in N-space for output between a currently displayed start point and a target point referenced by the identifier.

Claim 1 should be allowed as the Examiner has failed to establish a prima facie case of obviousness. To sustain a prima facie case of obviousness based upon a combination of references, the Examiner must point to some suggestion to combine the references. "The prior art must suggest the desirability of the claimed invention. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP 2143.01. This suggestion must be found in the prior art, and cannot be based upon Applicants' disclosure. "Obviousness may not be established using hindsight or in view of

the teachings or suggestions of the inventor." *Para-Ordnance Mfg. v. SGS Importers Int'l*, 73 F.3d at 1087, 37 USPQ2d at 1239, *citing W. L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d at 1551, 1553, 220 USPQ at 311, 312-13.

While Applicants do not acknowledge disclosure of the elements of the claimed invention by the references, Applicants submit that the Examiner has not identified any suggestion in any of the references to combine the various features allegedly taught by their respective references to achieve the invention claimed in this patent application.

The Examiner has failed to establish that the references suggest the desirability of the invention disclosed in claim 1. The Examiner has stated that it would be obvious to combine the disclosures of the '830 and '557 patents to achieve the invention recited in claim 1. However, the Examiner has pointed to nothing in either the '830 patent, the '557 patent or the prior art in general that suggests that an electronic tag, an electronic tag reader, and a computing system as disclosed in the '830 patent should be combined with the navigation system and method of viewing a data landscape in an information visualization system disclosed in the '557 patent to achieve Applicants' claimed invention.

The Examiner's latest arguments are not persuasive. The Examiner claims to recognize that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. However, the Examiner has appeared to overlook the admonition that this teaching cannot come from Applicant's disclosure. The Examiner states, "A person of ordinary skill in the art, seeing the advantages Want's invention provides with respect to input devices, would have been motivated to combine it and Pulley's graphical navigation system to create an intuitive and flexible method for navigating a flexible N-space." Applicant asks, why? The Examiner has asserted that a person skilled in

the art could combine these references, but he has provided no reason why they would. "The mere fact that references can be combined is not sufficient to establish prima facie obviousness." MPEP 2143.01.

More precisely, there are two scenarios by which one skilled in the art might be motivated to combine the disclosures of the '830 patent and the '557 patent. The Examiner has not argued either of these.

First, the Examiner has not shown that the '830 patent discloses navigation of an N-dimensional space. Want et al. disclose an electronic tag, a tag reader, and a computing system connected to the electronic tag reader for providing digital services. The Examiner has asserted no reason why a person skilled in the art would choose to add the 3D navigation system of the '557 patent to the disclosure of the '830 patent.

Second, Pulley et al. disclose a navigation system and method for viewing a 3D data landscape. The user provides input through a keyboard and a mouse. By entering input, the viewpoint within the data landscape changes. The Examiner has asserted no reason why it would be obvious to replace the mouse and keyboard of the'557 patent with the tag and tag reader of the '830 patent. In fact, an electronic tag and tag reader would probably add to the expense and complexity of Pulley et al.'s invention.

The Examiner may also be of the position that the invention claimed in the present application would be obvious to try after reviewing the cited references. Obvious to try, however, is not the standard by which obviousness is determined under 35 U.S.C. §103. In re Geiger, 2 U.S.P.Q. 2d 1276 (Fed. Cir. 1987); In re Yates, 211 U.S.P.Q. 1149 (CCPA 1981); In re Goodwin, 576 F.2d 375, 198 U.S.P.Q. 1 (CCPA 1978).

As the Examiner has failed to point to any motivation in the prior art to combine the references, the rejection should be withdrawn and claim 1 allowed.

For each of the above reasons, claims 2 and 4-8 should be allowed as claims 2 and 4-8 depend from claim 1.

Claim 9 recites a method for N-space navigation of digital data sets, including first reading a first electronic tag having a digitally readable identifier with an electronic tag reader, with the digitally readable identifier triggering a first default navigational action, and second reading within a determined duration of the first reading step a second electronic tag having a digitally readable identifier with an electronic tag reader, with the digitally readable identifier triggering a second default navigational action.

Claim 9 should be allowed as the Examiner has failed to establish a prima facie case of obviousness. As explained in Applicants' arguments in response to the rejections of claim 1, the Examiner has failed to identify a suggestion in the prior art to combine the navigational process of the '557 patent with the tag and tag reader of the '830 patent.

Claims 1 and 3-8 were rejected under 35 U.S.C. 103(a) as being unpatentable over Beigel et al, U.S. Patent No. 6,249,212, (the '212 patent) in view of Card et al., U.S. Patent No. 5,847,709 (the '709 patent). These rejections are respectfully traversed.

Claim 1 recites a system for N-space navigation of digital data sets, which includes an electronic tag having a digitally readable identifier, an electronic tag reader configured to read the identifier of the electronic tag, a computing system connected to the electronic tag reader to provide digital navigation services of N-space data sets in response to reading the identifier of the electronic tag, with the computing system generating at least one transitional data point in N-space for output between a currently displayed start point and a target point referenced by the identifier.

Again, claim 1 should be allowed as the Examiner has failed to establish a prima facie case of obviousness. To sustain a prima facie case of obviousness based upon a

combination of references, the Examiner must point to some suggestion to combine the references. "The prior art must suggest the desirability of the claimed invention. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP 2143.01. This suggestion must be found in the prior art, and cannot be based upon Applicants' disclosure. "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." *Para-Ordnance Mfg. v. SGS Importers Int'l*, 73 F.3d at 1087, 37 USPQ2d at 1239, *citing W. L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d at 1551, 1553, 220 USPQ at 311, 312-13.

While Applicants do not acknowledge disclosure of the elements of the claimed invention by the references, Applicants submit that the Examiner has not identified any suggestion in any of the references to combine the various features allegedly taught by their respective references to achieve the invention claimed in this patent application.

The Examiner has failed to establish that the references suggest the desirability of the invention disclosed in claim 1. The Examiner has stated that it would be obvious to combine the disclosures of the '212 and '709 patents to achieve the invention recited in claim 1. However, the Examiner has pointed to nothing in either the '212 patent, the '709 patent or the prior art in general that suggests that the electronic tag and electronic tag reader of the '212 patent should be combined with the computing system providing digital navigation services disclosed in the '709 patent to achieve Applicants' claimed invention.

Again, the Examiner's latest arguments are not persuasive. The examiner claims to recognize that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is sonic teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. However, again the

Examiner has appeared to overlook the admonition that this teaching cannot come from Applicant's disclosure. The Examiner states,

> [A] person of ordinary skill in the art would have realized that the tag and reader of Beigel would provide advantages similar to those provided by Want. Similarly, the person of ordinary skill in the art would have realized that the invention of Card requires an input device to operate (Card, Figure 1, reference characters 104 and 106, disclosing a keyboard and a cursor control device.) Thus a person of ordinary skill in the art, seeing the advantages Beigel's invention provides with respect to input devices, would have been motivated to combine it and Card's graphical navigation system to create an intuitive and flexible method for navigating a document data set.

The Examiner has asserted that a person skilled in the art could combine these references, but he has provided no reason why they would. "The mere fact that references can be combined is not sufficient to establish prima facie obviousness." MPEP 2143.01.

More precisely, there are two scenarios by which one skilled in the art might be motivated to combine the disclosures of the '212 patent and the '709 patent. The Examiner has not argued either of these.

First, the Examiner has not shown that the '212 patent discloses a computing system for the navigation of an N-dimensional space. Beigel et al. discloses universal electronic identification tag for use with a variety of readers. The Examiner has asserted no reason why a person skilled in the art would choose to add the three-dimensional document workspace of Card et al. to the disclosure of the '212 patent.

Second, Card et al. disclose a three-dimensional document workspace and a system for moving documents within the workspace. The user provides input through a keyboard or a cursor control device. By providing input to through the cursor control device or keyboard a user can move a document within the document workspace. The Examiner has asserted no reason why it would be obvious to replace the mouse and keyboard of the '709

patent with the tag and tag reader of the '212 patent. In fact, an electronic tag and tag reader would probably add to the expense and complexity of Card et al.'s invention.

As the Examiner has failed to point to any motivation in the prior art to combine the references, the rejection should be withdrawn and claim 1 allowed.

For each of the above reasons, claims 3-8 should be allowed as claims 3-8 depend from claim 1.

No additional fee is believed to be required for this amendment. However, the undersigned Xerox Corporation attorney hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025. This also constitutes a request for any needed extension of time and authorization to charge all fees therefor to Xerox Corporation Deposit Account No. 24-0025.

Respectfully submitted,

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